

Serial No.: 10/501,157

Agent Docket No.: AP020-04

AMENDMENTS TO THE DRAWINGS:

No changes to the drawings.

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REMARKS

The Applicant appreciates the courteous and complete examination of the application by the Examiner. In view of the foregoing amendments and the following remarks, a reconsideration of the instant application is respectfully requested.

DISQUALIFICATION OF REFERENCE UNDER COMMON OWNERSHIP

The Examiner imposes an election/restriction to the previously submitted claim 17. The Applicant respectfully withdraws and currently amends claim 17 to introduce the apparatus of claim 2, as discussed in our telephone conversation on 01/06/2006. With the allowance of claim 2, the Applicant respectfully requests the rejoinder of currently amended claim 17.

In view of the above-mentioned telephone conversation the Applicant requests a reconsideration of the restriction and that the restriction requirement be withdrawn and the amended claim 17 be reinstated and allowed.

The Examiner rejects claims 2-16 under 35 U.S.C. 103(a) as being unpatentable over Moreillon in view of Luhman. As per our telephone conversation, the Applicant submits a detailed listing of the structural differences between the claimed invention in the present application and the Moreillon and Luhman references relied upon by the Examiner.

The Applicant respectfully requests the removal of the 35 U.S.C. 103(a) rejections of claims 2-16 on the basis that the primary patent used by the Examiner (WO 99/61262) is disqualified as prior art reference under 35 U.S.C. 103(c) as having common ownership. A statement of common ownership is submitted herewith, as mentioned in MPEP 706.02(I)(2) which states: "Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a

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statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person."

STATEMENT OF COMMON OWNERSHIP

Application 10/501,157 to Borgeat and WO 99/61262 to Moreillon were, at the time the invention of Application 10/501,157 was made, owned by or subject to an obligation of assignment to BEST-PACK S.A.

The Applicant submits a letter signed by Moreillon and Applicant that states that the Moreillon reference and the PCT application which the present application claims priority to, are both commonly owned by BEST-PACK S.A.

STRUCTURAL DIFFERENCES TO PRIOR ART REFERENCES

The Applicant appreciates the fact that the Examiner has located patents directed to the means of preventing the escape of air for an air cushion making machine. In this respect, the claimed present invention still has substantial structural differences to the Moreillon and Luhman references which the Examiner relies upon for his rejection of the claims. The Examiner states that the Luhman reference discloses a similar means for preventing the escape of air comprise an elongated element (Figure 7, item 83) extending in a transverse direction attached to the first beam (pressing plate 80). Independent claims 2 and 12 are considerable different from the Luhman reference in that (item 83) in the Luhman reference are in fact 4 spring biased rods located at the corners of the pressing plate 80, and the purpose of the rods are to bias the plate 80 toward an outer position. One difference in claims 2 and 12 of the present invention is an elongated element attachable to a first beam which is received through a recess in a plate, and where an inflating means is also positioned on the first beam. The claimed elongated element is used to create tension on the tubular film and not

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used for being held away from the film while the latter is being moved, as stated by the Examiner.

The Examiner also states that the latter being introduced into a recess provided in a plate (item 81) on the frame of the machine to force the film into the recess to form a sealed fold. Items 80 or 83 are not introduced into a recess in plate (item 81), and item 81 is not a plate, it's disclosed as clamping bars. The Applicant understands that the Luhman reference discloses a nozzle being introduced into an opening and subsequently raising the center of the cushion to smooth and tension it around the nozzle. The nozzle is also used to inflate the cushion while a heating tube is pressed against the nozzle. The plate 2 and the elongated element 2b in claims 2 and 12 of the present application do not inflate or seal the cushion, they provide additional tensioning of the film, in combination with an inflating device and a welding device that are separate and independent from the plate and elongated element.

The nozzle in the Luhman reference is not attached to the pressing plate, it only passes therethrough, while the elongated element in the present application is attached to the first beam. Additionally, the Luhman reference has only one plate (item 80) that moves in a linear motion into position, while the present application claims two beams that pivot into position with a fixed plate featuring a recess positioned between the two pivoting beams. Furthermore, the claimed invention in the present application claims the elongated element and an inflating means attached to the first beam actuated by a first actuator, and a welding means attached to a second beam actuated by a second actuator. The Luhman reference makes no disclosure or teaching of this substantially different structure.

In this regard, the Applicant would point out that there is no teaching in the Luhman reference or that it would have been obvious to one skilled in the art to use the claimed structure combination to provide additional tensioning of the film using an elongated element that is separate and independent from the inflating and welding means as positioned on two pivoting beams.

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In the Examiner's response to arguments in the final office action dated 10/19/2005, the Examiner states that it "is true that small differences can be patentable." With that in mind, the present claimed invention is an improvement over the Moreillon reference, which is commonly owned. The Moreillon reference discloses a bar (26) and a plug (25) fixed on beam (12) between the first and second beams for pinching the film to prevent air from moving towards a reel. The Moreillon reference does not disclose or teach the use of an elongated element attached to the first beam in combination with a plate featuring a recess adapted to receive the elongated element therethrough. The bar (26) is not similar to the plate and the bar (26) does not have or teach the use of a recess therethrough to receive the plug (25). This substantially different structure is an improvement upon the commonly owned Moreillon reference.

With the Moreillon reference now disqualified as a prior art reference and that the Moreillon reference does not disclose or teach the above-mentioned structure, the Applicant's claimed invention is now patentably distinct to the Moreillon reference and would not have been obvious in light of the Luhman reference. Therefore the allowance of claims 2-16 and the reinstatement and allowance of amended claim 17 is respectfully solicited.

With the above amendments being fully responsive to all outstanding rejections and formal requirements, it is respectfully submitted that the claims are now in condition for allowance, and a notice to that effect is earnestly solicited. Should the Examiner feel that there are further issues which might be resolved by means of telephone interview, the Examiner is cordially invited to telephone the undersigned at 403-547-1592, or email at davidguerra@verizon.net.

Respectfully Submitted,



David A. Guerra, Reg. 46,443

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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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On (Date) 1/18/06 by David A. Guerra 